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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,110	11/27/2001	James Fletcher	FLTCHR2	9399

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EXAMINER

MADSEN, ROBERT A

ART UNIT PAPER NUMBER

1761

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,110

Applicant(s)

FLETCHER, JAMES

Examiner

Robert Madsen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: items (c) and (d) in Figure 3 are not legible.
2. Additionally, Table I should either be labeled as a "Figure" or included within the specification.
3. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for providing a supply of edible meat of a mollusk that is known to be fed upon by the crustacean that is being simulated, does not reasonably provide enablement for "the primary mollusk" recited in independent claims 1, 7, and 13. The specification does not enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims (i.e. How does one determine the *primary* mollusk that is fed upon?). Furthermore, applicant's attention is directed to the Maine Aquarium Website, which notes that Maine lobsters eat " [m]ussels, clams, urchins, and flounders", and The Northeast Fisheries Science Center Website (the research arm of the National Oceanic and Atmospheric Administration), which states that Lobsters food includes "fish, crabs, clams, mussels, sea urchins, and sometimes other lobsters". There is no mention of Atlantic sea scallops (or scallops in general) being "the primary mollusk" for Main Lobsters (or lobsters in general), as recited in dependent claims 5 and 11. For examination purposes "the primary mollusk" will be understood to be "a mollusk".

6. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 7, and 13 recite the mollusk meat is formed into "smaller, natural pieces that are comparable in volume to that of the typical crustacean " that the natural pieces are intended to simulate. First, it is not known how one determines a "natural piece" (e.g. before or after cutting open a crustacean) Second it is not known what the volume of a *typical* crustacean meat piece is (i.e. volume of Lobster vs. shrimp). For examination purposes, this limitation is met by forming smaller pieces of a mollusk meat to simulate a crustacean.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Juarez, et al. (ES 2019193).

9. Juarez et al. simulating crab meat by providing a supply of mollusks, cooking, mincing (exerting a force to form smaller pieces). See English Abstract.

10. Claims 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Juarez, et al. (ES 2019193).

Juarez et al. simulating crabmeat with supply of cooked small pieces of mollusks (Abstract). Although, Juarez does not expressly teach the particular method of preparing, the end result is the same: a simulated crabmeat with supply of cooked small pieces of mollusks. These are product by process claims, it is noted that “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 1,2,5-8,11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yueh (US 3863017) in view of Joaquin (US 3532512) and Sugino et al. (US 4362752).

13. Regarding claims 1,2, 7,8,and 13, Yueh teach forming simulated lobster based on fish fibers (small pieces) and a binder that is cooked and formed in the lobster shape (Column 1, lines 20-67). However, Yueh is silent in teaching using scallops, and the scallop meat is fresh and not soaked in water as recited in claim 2 and 8.

14. Joaquin teaches using scallop fiber pieces to form more expensive fish meat (Column 1, lines 12-70), wherein raw and dry meat is added , without soaking in water, and the pieces are broken along their natural break lines (note Figure 1 in light of column 2, lines 17-52).

15. Sugino et al. are relied on as further evidence of the conventionality of forming a lobster based other mollusk meat (e.g. cuttlefish or squid) meat (Abstract , Column 4, lines 25-32, Column 4, line 65 to column 5, line 8).

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16. Examiner takes official notice that 1 pound of lobster meat is more expensive than 1 pound of scallops meat.

17. Therefore, it would have been obvious to substitute the fish fiber pieces of Yueh with scallop pieces of Joaquin since (1) pound for pound lobster meat is more expensive than scallops, (2) Joaquin teaches utilizing scallop fiber pieces to form more expensive pieces of fish, (3) it was well known to utilize other mollusks for forming simulated lobster. It would have been further obvious to utilize dry, fresh scallops, as recited in claim 2 and 8 since Joaquin teaches using raw dry scallops that are divided up into fiber pieces, and one would have been substituting one fish fiber piece for another for the same purpose: a simulative piece of fish.

18. Regarding claims 5 and 11, Yueh modified is silent in teaching Maine Lobster and Atlantic Sea Scallops. However, once it was known to form a simulative lobster with scallops, to select any particular type of lobster simulation or scallop would have been an obvious matter of choice, depending on (1) the desired appearance of the lobster (i.e. the appearance of Gulf Of Mexico Lobsters is distinct from Maine Lobsters) and (2) the desired size of the scallops/amount of meat per shell (i.e. Atlantic Sea Scallops are larger than Bay Scallops and provide more meat per "exerting force").

19. Regarding claim 6 and 12, as discussed above in the rejection of claims 1, 2 and 13, Joaquin teaches the scallop pieces are broken along their natural lines of separation when the meat fibers are used for forming a simulated fish meat (Column 2, lines 17-52). Therefore, it would have been further modified Yueh and break the scallop pieces along their lines of separation since Joaquin teaches this allows for the separation of

fish fibers and one would have been substituting one method of obtaining fish fibers for another.

20. Claim 3,4,9,10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yueh (US 3863017) in view of Joaquin (US 3532512) and Sugino et al. (US 4362752) as applied to claims 1,2,5-8,11-13 above further in view of Ikeuchi et al. (US 4692341),

21. Regarding claims 3 and 9, Yueh teaches lobsters, but is silent in teaching crab. Ikeuchi et al. teach a method of forming lobsters and crab utilizing the same method (Abstract). Therefore, once it was known to utilize one method for simulating lobster with scallops, it would have been obvious to also produce crab by the same method since one would have been substituting one crustacean for another for the same purpose: providing a simulated product.

22. Regarding claims 4 and 10, these claims have the same limitations as claims 6 and 12 and are rejected for the same reasons as claims 6 and 12.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Corser et al. (US 5827588) and Rubin (US 3852505) teach molding small pieces of shrimp to form simulated jumbo shrimp. Hanson et al. (US 4579741) and Shimura et al. (US 4303688) teach fabricating seafood with scallop pieces.


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24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (703)305-0068. The examiner can normally be reached on 7:00AM-3:30PM M-F.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703)308-3959. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9310.

26. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0061.

Robert Madsen
Examiner
Art Unit 1761



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